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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/043,028 | 01/09/2002 | Alain Benayoun | FR920000082US1 | 6133 |
| 25299 | 7590 | 11/16/2005 | EXAMINER | |
| IBM CORPORATION PO BOX 12195 DEPT YXSA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709 | | | LIOU, JONATHAN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2663 | |

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H-13

| | | |
|------------------------------|-----------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/043,028 | BENAYOUN ET AL. |
| | Examiner | Art Unit |
| | Jonathan Liou | 2663 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 January 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 and 17-19 is/are rejected.
- 7) Claim(s) 13-16 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 January 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Objections

1. Claims 13-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 11. See MPEP § 608.01(n). Accordingly, the claims 13-16 would not been further treated on the merits.

Regarding claims 13 and 15, claim 13 and 15 are also multiple dependent claims and could not depend on claim 11 since claim 11 are also a multiple dependent claim.

Regarding claims 14 and 16, claims 14 and 16 would not be considered as the proper claims since they depend on claims 13 and 15 and claims 13 and 15 are improper.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,904,046.

Regarding claim 1, although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-2 of U.S. Patent No. 6,904,046 teach all of the limitations except the memory control means. Nevertheless, in claims 1-2 of U.S. Patent No. 6,904,046, Benayoun et al. teach a memory block could perform the limitations that memory control means could perform except for memory control means analyzes all the byte following header when header includes a specific configuration indicating that said packet is a multicast address packet preceding a multicast frame in order to determine whether the packets of said multicast frame are to be forwarded to said output port recited in the claim 1 of application. Furthermore, Benayoun et al. further teach detecting whether the packet is a multicast address packet. If so, the header of the packet has a specific configuration determining that all the following packets, which have all a specific header, are the packets of a multicast frame. In such a case, the header configuration and setting block 212 analyzes also the 54 bytes of the packet following the header to determine whether the output port associated with the memory block corresponds to one of the output ports to which the multicast frame is addressed (See col 5, lines 3-12, Benayoun et al.) Thus, it would have been obvious for one having ordinary skill in the art at the time invention was made to include the memory control means because it could have advantage to determine whether the output port associated with the memory block corresponds to

one of the output ports to which the multicast frame is addressed (See col 5, lines 8-12, Benayoun et al.)

Regarding claims 2-3, these claims have the same limitations as claims 2-3 of the patent.

Regarding claims 4-6 and 10, the patent teaches the data transmission system according to claim 3. The patent does not specifically limitations in claims 4-7 and 10 in the claim language. However, the patent disclosed the limitation for claims 4 and 10 of the application in the specification (see col 5-6, lines 59-4, Benayoun et al.); the patent disclosed the limitation for claims 5-6 of the application in the specification (See col 6, lines 4-26, Benayoun et al.) Thus, it would have been obvious for one who have ordinary skill in the art at the time the invention was made to use a validation signal and output data block because this would have advantage on the memory flow control function for scheduler to control the overflow (see col 5-6, lines 65-4, Benayoun et al.)

Regarding claims 7, the claim 1 of the patent teach packet switch includes a plurality of switch modules except defining the addresses of the output ports of said module to which multicast frame is to be forward. However, the patent disclosed this limitation in the specification (see col 5, lines 3-12, Benayoun et al.) The same basis and rationale as applied to claim rejection 1 are applied.

Regarding claims 8-9, these claims have the same limitations as claims 8-9 of the patent.

Regarding claims 11-12, the patent teaches the overflow in the claim except the functionalities of overflow signal and overflow bus. However, the patent teaches all the

limitation of claims 11-12 in the specification of the patent (See col 5, line 28-45 and col 6-7, lines 60-22, Benayoun et al.)

Regarding claims 17-19, claim 17 are broadens the scope of the claim 1 of the application. The patent teach a cross point is defined at which is located a memory block in claim 1 of the patent and teaches multiple of memory blocks in each of switch modules; hence, a switch module having at least two crosspoints and a memory is coupled to each one of at least two crosspoints. In addition, the patent teach at least two adapters operatively coupled to the switch module because each switch module connected with at least one input and one output port, which go to the adapters. The LAN is couple to each of the adapters as taught in the claim 1 of the patent. The patent also teach the memory controller to perform all the limitations of claim 17 in claim 1 and 2 of the patent except the limitation of indicating packet is a multicast address packet preceding a multicast frame in order to determine whether the packets of said multicast frame are to be forwarded to output port. Nevertheless, the patent disclosed this limitation in the specification (see col 5, lines 3-12, Benayoun et al.) The same rationale and basis as applied to claim rejection1 are applied.

Conclusion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Liou whose telephone number is 571-272-8136. The examiner can normally be reached on 8:00AM - 5:00PM Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jonathan Liou

11/09/2005



RICKY NGO
PRIMARY EXAMINER